

REMARKS

This response is submitted by the due date of March 29, 2005 in response to the Office Action mailed December 29, 2004. In the Office Action, the Examiner rejected Claims 1-30, for the reasons of record, rejecting the above claims as being un-patentable over Merritt et al in view of Doviak et al.

The applicant respectfully submits and once again respectfully appeals that the pending claims 1-30 patentably distinguish over Merritt et al and Doviak et al and merit further reconsideration for the reasons set forth below in extensive detail:

1. Priority over Doviak et al: The applicant claims priority for the present applications which is a continuation in part application of Rao et al's parent application. The present CIP application further teaches novel means for dynamically configuring mobile communication devices.

1.1 The applicant respectfully submits that Rao et al should be accorded priority over Doviak et al in view of the filing date of Rao et al which is dated June 9, 2000; whereas Doviak et al was filed on June 10, 2002. Hence, the present Rao et al filing precedes the Doviak et al filing by just over two years and for reasons of record the Rao et al filing is entitled to receive priority over Doviak et al.

1.2 Additionally, the present Rao et al application is a continuation in part of the original Rao parent filing 08/764,903, dated December 16, 1996; and the successors of this original Rao filing are now US Patents US 6,169,789 [filed June 4, 1999 and granted January 2, 2001] and US 6,480,587 [filed August 21, 2000 and granted November 12, 2002]. Hence, the parent Rao et al disclosure filed December 16, 1996 precedes the Doviak et al disclosure which was filed on September 17, 1997.

1.3 In addition to the significant differences in the Rao teaching versus Merritt and Doviak, the above priority for Rao is significant and important in view of the enabling system level scheme disclosure of Rao et al in their root filing 08/ 764, 903 of December 16, 1996, related to the ability to leverage the communication and other capabilities of a mobile communication, computation, and command device in conjunction with a central server by wired or wireless communication means.

1.4 The Rao et al teachings clearly relate to various communication functions: "The intellikeyboard may work in tandem with a local or network server to perform standard computing functions, serve as a command and control unit, perform standard telephony functions, transmit and receive electronic mail, voice mail, video and audio" as stated in the abstract and in the specification of Rao's US 6,169,789.

1.5 Additionally, even after review of the parent Doviak et al filings dated June 1, 1995 and September 17, 1997, it is clear that Doviak does not teach the essential novel elements taught by Rao et al in their parent filing dated December 16, 1996 or for that matter the present Rao application dated June 9, 2000. Doviak in the various filings does not disclose the means for transformation of a communication device for a multiplicity of communication protocols. Doviak's disclosures relate to connecting a mobile device with a separate mobile data controller in

combination with a remote network controller such that incompatible protocols are transparent to the remote device and the host network. Whereas, Rao et al enable the mobile device to dynamically transform itself by software means for communication using a first communication protocol to a second communication protocol using the capabilities of the mobile device itself and or the central server including being independent of an intermediary devices such as the mobile data controller and the remote network controller referred to by Doviak. The operating parameters such the frequency, power, bandwidth of the mobile communication device are enabled for transformation in the Rao disclosure for appropriate communication, which is not enabled in the Doviak teaching.

1.6 The applicant[s] respectfully request that priority be granted to Rao et al in view of the above and the examiners objections [citing Doviak and Merritt] to the claims of the present Rao invention merit reconsideration.

2.0 Rao et al precede Merritt and Doviak in teaching mobile communication devices that can communicate with a central server, using one or more channels of communication:

The examiner clearly states in the Office Action dated December 29, 2004 [page 4] that

“Merritt fails to teach that the subscriber is a mobile device. However, Doviak teaches that a subscriber is a mobile device (col 11 lines 16-32).

In view of the above comments related to differences between the teaching of Rao versus Doviak, clear reasoning and cited priority as stated in 1.1 through 1.6, Rao et al clearly deserve priority over Merritt and Doviak for the reasons of record for the teaching of a mobile device that can communicate with a central server for a range of wired and wireless communications; especially a mobile device that can dynamically be configured by software means for operation from a first set of communication and operation parameters to a second set of communication and operating parameters using the processing capabilities of the mobile device by itself or of the mobile device in conjunction with the processing capabilities of a central server.

3.0 Regarding Claims 1, 5-8, 10, 14-15, 17-18, 24-25 :

3.1 The Merritt teaching relates to a system for interchanging image information and is clearly distinct from the Rao teaching which relates to a broad range of applications not anticipated by Merritt et al. The Merritt teaching as stated in the abstract and throughout the specification refers to a “multitude of dissimilar end system devices, appliances and platforms to exchange image information”, which is a simple information exchange activity between stationary devices that does not result in the specific underlying functionality of the device being altered in any way. However even in this aspect, Rao et al claim priority even over Merritt et al [Rao et al original filing December 16, 1996 versus Merritt et al filing dated March 18, 1998] as the Rao original disclosure covers the communication of voice, data, image, video and audio information between a mobile device[intelligent keyboard] and a central server.

3.2 Rao et al therefore believe that they distinguish and further have priority over Merritt and Doviak in view of 3.1 and the reasons stated in section 1.0 above and further assert that the Rao teaching is distinct and separate from Merritt and Doviak. Further, Merritt does not teach the capability for dynamically transforming a mobile communication device configured for a first application to a second application by software means by either using the internal processing capabilities of the communication device by itself or by using the processing capabilities of a central server by wired or wireless means.

3.3 Referring to Fig. 1A and Fig.1B of Merritt et al:

Merritt et al in Fig.1A and Fig.1B refer to the conversion of the image from a first format to a second format using a network based image processing node and a network based image conversion server for use by the calling party and the called party. The applicant respectfully submits that the specific device used by either the calling party or the called party is in no way transformed from a first function to a second function in the Merritt teaching whereas Rao et al teach that the calling party [mobile device 1] and the called party [mobile device 2] may each be transformed from performing a first function to a second function in conjunction with the processing power resident within each device or in conjunction with the processing capabilities of a central server. Consequently, the applicant respectfully submits that the cited figures 1A and 1B are not applicable to the Rao disclosure of the present invention. In the Merritt figures 1A and 1B the calling device and the called device simply receive image information that has been externally converted from a first image format to a second image format; and Merritt does not teach either the calling device or the called device utilize their own internal processing capabilities in a standalone manner or that of the central server to transform them selves from a first function to a second function nor for that matter are enabled for any form of conversion internal of said calling party device or the called party device.

3.2 Merritt Col 3 lines 51-65:

The examiner states that "Merritt teaches means for dynamically configuring the functionality of the device by software means without altering the hardware configuration". Merritt describes that a number of discrete servers are networked on a data link and the calling device and the called device may connect to the network using either Ethernet or FDDI; no where does Merritt maintain that the calling device and the called device can dynamically transform them selves for connections using at a first point in time with Ethernet and at a second point in time with FDDI or other protocols; for in order to execute such transformation within the calling device or the called device the said called and or calling devices must be empowered with internal processing capabilities and or must be able to leverage external processing capabilities; no such intelligence within the calling device/called device is described. The described functions of the discrete servers of the Merritt teaching is simply image conversion for communication on a pre defined communication path such as Ethernet or FDDI that the calling device or the called device uses. No where does the called device/calling device dynamically transform itself from Ethernet to 802.xx or other communication protocols.

The functions that Merritt et al refer to is queuing of image conversion requests, password login and others and definitely do not describe the very conversion of the calling device or the called device from a first communication protocol to a second communication protocol which Rao et al do.

3.3 Merritt Col 6 lines 37-50:

In this instance Merritt et al refer to image communication using the store and forward mode either selected by the party or that may occur as a result of a failed attempt at connecting with the party.

“For instance, in response to the call arriving at the image nodal processor, the image communications manager 22 may direct an audio response unit to prompt the caller to enter the preferred communication mode using the touch –tone key pad on a telephone station or by entering a response from the keyboard of the calling device” There is no question that this is a manual system in the Merritt teaching and is not enabled for dynamic sensing nor conversion of the communication protocols from a first communication protocol to a second communication protocol. Whereas, in the Rao teaching the mobile communication device is enabled for recognition of the communication protocol and for conversion of the capabilities of the communication device from a first communication protocol to a second communication protocol such as from Bluetooth to Ethernet and others utilizing its built-in processing and other capabilities in a standalone manner or in conjunction with a central server.

Upon further reading, in line 57 Merritt et al state, “The image communication session manager then initiates a communication by voice mail and or e-mail, for example to the called device station using a station identifying number (e.g., phone number) stored in the image profile database 24. The terminology and common usage of the word “communication protocols” in the Rao invention refers to the communication means such as Ethernet, 802.xx, Bluetooth and others; whereas the Merritt teaching in this case refers to the “communication forms” such as e-mail, voice mail etc. which are distinct and separate in both meaning and intent. For example the Rao invention enables the mobile device to dynamically adjust various device parameters such as frequency of transmit/receive, power levels and other factors that are absolutely essential for communication using different communication protocols; and such features are not taught by Merritt et al.

3.4 Col 2 lines 50-67 and Col 3 lines 1-6:

The cited Col. and lines do not negate the novelty of the Rao teaching and are not relevant for the reason that the Merritt et al in line 54, refer to “a plurality of image processing nodes 12, each which supports the image communication protocol, would access a centralized database 14, while a separate image conversion server 16 preferably would be located at each node and be accessible to other nodes via a gateway or bridge”. The architecture and system described by Rao et al in the present invention is distinctly different [see Fig. 2A, 2B and 2C], and comprises of a mobile device, said mobile device having significant internal processing and other capabilities for dynamic operation in a standalone manner or is enabled for conversion from a first communication protocol to a second communication protocol for various forms of communication including image, voice and data communication. In the Rao teaching the mobile device is enabled for dynamic conversion of the images within the mobile device itself or in conjunction with a central server and does not rely solely on an image conversion server.

For reasons of brevity, Rao et al submit that the above reasons for allowance cited by the applicant are equally applicable to various other claims, 1-30, that have been currently disallowed by the examiner. Consequently, the applicant respectfully requests that the claims 1-30 as previously

submitted warrant reconsideration and approval.

The applicant is available in the event the examiner wishes to discuss the present invention over the phone at the telephone number below.

Respectfully submitted

A handwritten signature in black ink, appearing to read "Raman K. Rao".

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